

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 28

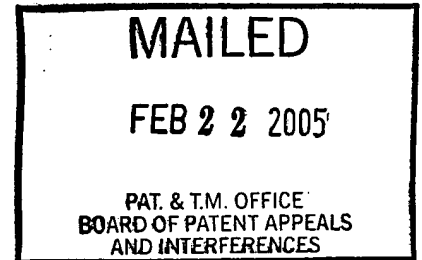
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ARNAUD CAPITANT, CHRISTOPHE FRANCOIS, SOPHIE FREY,
ABDALLAH HITTI, OLIVIER JEAN MARIE, PHILIPPE LUCAS, PHILIPPE
MERCIER, and JEAN-PHILIPPE WARY

Appeal No. 2004-1885
Application No. 09/332,489

ON BRIEF



Before RUGGIERO, BARRY, and LEVY, Administrative Patent Judges.
RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-22, which are all of the claims pending in the present application.

The claimed invention relates to a process for making remote payments for goods purchased by a buyer from a supplier within an open network. The buyer utilizes a mobile radiotelephone operating within a closed radio communications network which is managed by a management center. After a request from the

Appeal No. 2004-1885
Application No. 09/332,489

supplier within the open network, a buyer identification procedure is performed by the management center, and/or a payment server, and/or a control center, thereby ensuring that the buyer is a correctly registered subscriber on a list of subscribers to the closed radio communications network.

Claim 1 is illustrative of the invention and reads as follows:

1. Process for remote and secure payment for goods and/or a service purchased by a buyer from a supplier within an open network, making use of a mobile radiotelephone within a closed radiocommunications network used by the buyer, the mobile radiotelephone enabling access to the closed radio communications network managed by a management center, a payment server being connected to the closed radio communications network, characterized in that the process includes the following step:

identification of the buyer by the management center and/or the payment server and/or a control center based on a request from the supplier within the open network, the buyer identification consisting of making sure that the buyer is a subscriber correctly registered on a list of subscribers to the closed radio communications network.

The Examiner relies on the following prior art:

Fougnes et al. (Fougnes)	6,236,851	May 22, 2001 (effectively filed Nov. 15, 1995)
Wagner	6,366,967	Apr. 02, 2002 (effectively filed Jun. 22, 1995)

Appeal No. 2004-1885
Application No. 09/332,489

Claims 1-22, all of the appealed claims, stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Fougnyes in view of Wagner.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs¹ and Answer for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Briefs along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 1-22.

¹ The Appeal Brief was filed November 24, 2003 (Paper No. 23). In response to the Examiner's Answer dated January 14, 2004 (Paper No. 24), a Reply Brief was filed February 17, 2004 (Paper No. 25), which was acknowledged and entered by the Examiner as indicated in the communication dated March 30, 2004 (Paper No. 26).

Appeal No. 2004-1885
Application No. 09/332,489

Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed.

Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

With respect to independent claim 1, the sole independent claim on appeal, Appellants' arguments in response to the obviousness rejection initially assert a failure by the Examiner to establish a prima facie case of obviousness since all of the claimed limitations are not taught or suggested by the applied prior art references. After reviewing the applied Fougnes and Wagner references in light of the arguments of record, we are in general agreement with Appellants' position as stated in the Briefs.

Our interpretation of the applied Fougnes and Wagner references coincides with that asserted by Appellants (Brief, pages 6-12; Reply Brief, page 3). We agree with Appellants that, in contrast to the claimed invention which requires a combination of open network and closed network communication processing in which closed network buyer identification is utilized to enable purchases by the buyer over an open network, Fougnes provides only for the purchase of services over a closed network while Wagner provides for data transactions only through an open

network. Given this deficiency in the disclosures of the applied prior art, we can find no teaching or suggestion, and the Examiner has pointed to none, as to how and in what manner the Fougnyes and Wagner references might be combined to arrive at the claimed invention. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

It is also our view, that, even assuming, arguendo, that proper motivation were established for modifying Fougnyes with Wagner, there is no indication as to how such modification would address the particulars of the claim language of independent claim 1. As discussed previously, the language of claim 1 sets forth a specific combination of the use of closed network buyer identification to enable purchasing by a buyer of goods and services over an open network. More particularly the language of claim 1 requires that buyer identification is based on a request from a supplier over an open network, with the buyer identification performed over a closed network to ensure that the

buyer is properly registered as a subscriber to the closed network. In our view, the proposed combination of Fougnyes and Wagner would, at best, result in the substitution of the open network data transaction system of Wagner for the closed network system of Fougnyes, a result which falls far short of the specific combination set forth in the appealed claims. Given the factual situation presented to us, it is our opinion that any suggestion to make the combination suggested by the Examiner could only come from Appellants' own disclosure and not from any teachings or suggestions in the references themselves.

We also recognize that the Examiner, in the "**Response to Argument**" portion of the Answer at page 9, offers a differing interpretation of the language of claim 1. According to the Examiner, the wording "based on a request from the supplier within the open network" can be construed as applying only to the third listed identification option, i.e., the control center. We find, however, as asserted by Appellants (Reply Brief, page 2), no basis for the Examiner interpreting the claim language in this

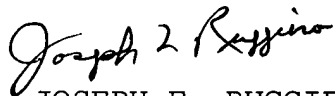
Appeal No. 2004-1885
Application No. 09/332,489

manner. While it is true that limitations may not be imported into the claims from the specification, it is equally true that claim language must not be read in isolation but, rather, must be interpreted in light of the disclosure in the specification. It is apparent to us from a review of Appellants' specification, for example, at pages 3, 5, 6, and 10, that the condition of a buyer identification request from a supplier over an open network must be interpreted as applying to all three of the recited identification options, i.e., the management center, the payment server, and the control center.

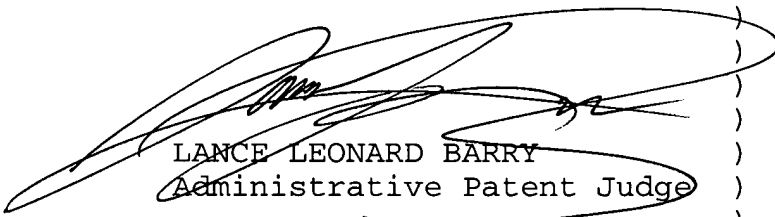
Appeal No. 2004-1885
Application No. 09/332,489

In view of the above discussion, since we are of the opinion that the prior art applied by the Examiner does not support the obviousness rejection, we do not sustain the rejection of independent claim 1 nor of claims 2-22 dependent thereon. Therefore, the decision of the Examiner rejecting claims 1-22 under 35 U.S.C. § 103(a) is reversed.

REVERSED

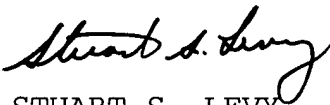


JOSEPH F. RUGGIERO)
Administrative Patent Judge)



LANCE LEONARD BARRY)
Administrative Patent Judge)

BOARD OF PATENT
APPEALS AND
INTERFERENCES



STUART S. LEVY)
Administrative Patent Judge)

JFR/hh

Appeal No. 2004-1885
Application No. 09/332,489

KINNEY & LANGE, P.A.
THE KINNEY & LANGE BLDG.
312 SOUTH THIRD STREET
MINNEAPOLIS, MN 55415-1002